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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341

7590 07/31/2003

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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/771,416	PELLERIN, DANIEL
Examiner	Art Unit	
Jila M Mohandes	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 May 2003 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 4-7 and 9 is/are allowed.

6) Claim(s) 1-3,8 and 10-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s). _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 19 May 2003 for a request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/771,416 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses", and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses, claim 19, lines 13-14, the limitations "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being

shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the applicant intends to claim the combination of a cleat and a baseball shoe or is claiming the subcombination of a cleat for use with the baseball shoe. This is because in many instances claims which appear to be drawn only to the subcombination of the cleat (no baseball shoe has been claimed), are further structurally limited with reference to the baseball shoe. For example only, claim 1, line 1 appears to clearly indicate that no baseball shoe is claimed (the claim is drawn to a cleat for use with a baseball shoe). On the other hand line 2 recites limitation which are dependent on the size of the recess in the baseball shoe. All of the claims should be reviewed for this type of error. With respect to claims such as claims 2, and 16 the claims actually appear to recite that there is a baseball shoe while also appearing (at least from the preamble thereof) to be drawn only to the subcombination of a cleat for use with a baseball shoe. In this office action all references in the claims to the baseball shoe where they are not expressly recited in combination with the claimed cleat is not

considered to be further structurally limiting with respect to the cleat. The examiner will treat such references to the baseball shoe as merely the applicant's statement of intended use of the cleat in order to give the claims their broadest reasonable interpretation pursuant to PTO practice. On the other hand clarification of the scope of the above noted claims is required in response to this office action.

Specification

6. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

7. Claim 28 is objected to because of the following informalities: in line 28, "that said" appears to be –than said--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. It is noted that the term "universal cleat" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Rogers (1,055,229). Rogers '229 discloses a cleat for a baseball shoe comprising:

- a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;
- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has

all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers '229 is inherently capable of receiving a retaining screw.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers '229.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

Allowable Subject Matter

13. Claims 4-7 and 9 are allowed.

Response to Arguments

14. Applicant's arguments, see arguments, filed march 14, 2003, with respect to the rejection(s) of claim(s) 1-9 under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rogers '229.

15. The declaration under 37 CFR 1.132 filed 14 March 2003 is insufficient to overcome the rejection of claims 1-9 based upon the rejection of claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) as set forth in the last Office action because: The declaration does not set forth facts and does not demonstrate that the commercial success is due to the invention alone.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are cleats analogous to applicant's inventions.

5. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical

personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Jila M Mohandesi
Examiner
Art Unit 3728

JMM
July 25, 2003